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UNITED STATES PATENT AND TRADEMARK OFFICE
_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
_____

Ex parte TETSURO MOTOYAMA, AVERY FONG,
and YEVGENIYA LYAPUSTINA
_____

Appeal 2008-3003
Application 09/393,677[1]
Technology Center 2100
_____

Decided: January 29, 2009
_____

Before JOHN C. MARTIN, LANCE LEONARD BARRY, and
JEAN R. HOMERE, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* HOMERE.

Opinion Concurring filed by *Administrative Patent Judge* MARTIN.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1, 5 through 9, 13 through 17, 21 through 25, and 29 through 36. Claims 2 through 4, 10 through 12, 18 through 20, and 26 through 28 have been cancelled.[2] We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

Appellants' Invention

Appellants invented a method and system for monitoring how a user utilizes the control panel of an image forming device such as a copier, a facsimile, or a printer. (Spec. 3.) Particularly, as depicted in Figure 13, upon starting up a target application, an object calls a monitoring function to start monitoring the user's usage of the control panel. (Spec. 20, ll. 22-27.) The target application can be an image forming device or a software application. (Originally filed claims 2 and 3.) As shown in Figure 9, the monitoring unit records the monitored usage data in a log stored in the device. (Spec. 19, ll. 9-11.) At a designated time, a communicating unit (520) receives the usage logged data and subsequently forwards it to a designated party. (Spec. 19, ll. 11-14.)

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[2] In the status of claims section, Appellants incorrectly indicate that claims 1, 5 through 9, 13 through 17, 22 through 25, 31 and 32 are pending in this application. (App. Br. 2.) Since the record before us indicates that claims 21, 29, 30, 33 through 36 are also pending, we treat Appellant's incorrect statement as a mere typographical error.

2

Illustrative Claim

Independent claim 1 further illustrates the invention. It reads as follows:

1. A system comprising:

an image forming device comprising an operation panel, the operation panel comprising a plurality of operations to be selected by a user;

a monitoring unit configured to monitor data of selecting of the plurality of operations of the operation panel by the user, and to generate a log of the monitored data, the log of the monitored data being stored in the device, and to automatically start the monitoring without requiring a connection to a receiving device to which the log of monitored data is to be sent and automatically upon start-up of the image forming device without the user directly starting a monitoring program;

a communicating unit configured to receive the log of the monitored data, and to automatically communicate the log of the monitored data by a unidirectional communication without requiring input from the device to which the log of the monitored data is to be sent.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

| Boulton | 5,566,291 | Oct. 15, 1996 |
| Varga | 6,181,981 B1 | Jan. 30, 2001 |

Rejection on Appeal

The Examiner rejects the claims on appeal as follows:

Claims 1, 5 through 9, 13 through 17, 21 through 25, and 29 through 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Boulton and Varga.

Appellants' Contentions

Appellants argue that one of ordinary skill would not have been led to combine Boulton with Varga in the manner suggested by the Examiner to render independent claim 1 unpatentable. (App. Br. 9-14, Reply Br. 1-4.) Particularly, Appellants argue that the ordinarily skilled artisan would not have looked to Varga's inventory maintenance for a vending machine to modify Boulton's user feedback implementing system to yield the claimed usage monitoring image forming device. (App. Br. 10.) Further, Appellants argue that Boulton's requirement for a user to initiate an action to input feedback information to be monitored and reviewed by another party teaches away from the automatic monitoring of the user's selected operations upon start up of the image forming device, as required by claim 1. (App. Br. 11, Reply Br. 2-3.)

Examiner's Findings/Conclusions

The Examiner finds that Boulton's disclosure of monitoring a user's feedback within a feedback interface *substantially* teaches automatically monitoring the user's interaction with the image forming device, as recited

in independent claim 1. (Ans. 7.) Further, the Examiner finds that while
Boulton requires a user's action to initiate the feedback gathering process, it
does not require such user action to monitor the gathered feedback. (*Id.*)
Particularly, the Examiner finds that by recording the feedback record time
at which the feedback is made, Boulton implicitly teaches automatically
monitoring the user entered feedback. (*Id.*) Therefore, the Examiner
concludes that Boulton and Varga are properly combined to render claim 1
unpatentable. (*Id.*)

II.   ISSUE

Did Appellants show that the Examiner erred in concluding that the
combination of Boulton and Varga renders the claimed invention
unpatentable? Particularly, the issue turns on whether the ordinarily skilled
artisan would have found sufficient rationale to combine the cited references
to teach the recitation of upon start up of the image forming device,
automatically starting monitoring selected operations of a user on a panel
interface without the user directly starting the monitoring program, as recited
in independent claim 1.

III.   FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance
of the evidence.

Boulton

1a.   Boulton discloses a system having an interface for allowing a user to select the desired feedback attributes therefrom and to enter therein his/her feedback relating to his/her experiences in a specified context or location. (Col. 4, ll. 5-10, col. 39, ll. 44-47.)

1b.   Upon issuing a command to select a feedback mode, the attributes associated with the selected mode are automatically recorded in the feedback record. Particularly, the feedback record automatically stores the user's comments, the selected categories, product, service, physical location, and issue. (Col. 4, ll. 12-22.)

1c.   Additionally, the feedback record stores the time at which the feedback including user's input and the selected attributes were entered. (Col. 4, ll. 22-39).

1d.   The collected user feedback is subsequently forwarded to a reviewer. (Col. 4, ll. 40-49.)

Varga

2.   Varga discloses a system for maintaining inventory on a self-monitoring vending machine. Particularly, information concerning dispensed goods are collected and transmitted to a remote location for processing and scheduling servicing. (Abstract.)

6

IV. PRINCIPLES OF LAW

Obviousness

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

> Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," and discussed circumstances in which a patent might be determined to be obvious. *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. at 1739). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 127 S. Ct. at 1741).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *See In re Kahn*, 441 F.3d at 987-988; *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991); and *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826 (CCPA 1968).

V.   ANALYSIS

Independent claim 1 recites in relevant part upon start up of the image forming device, automatically starting monitoring selected operations of a user on a panel interface without the user directly starting the monitoring program. As set forth in the Findings of Facts section, Boulton discloses a feedback implementing system wherein a user's selections and inputs in the feedback interface are automatically recorded in a log upon the user entering the feedback mode. (FF. 1a-1b.) Boulton also discloses automatically recording the time at which the user interacts with the feedback system. (1c.) While the cited disclosures of Boulton teach automatically monitoring the user's interaction with the feedback system upon the user entering the feedback mode, such monitoring is not performed upon start up of the feedback device. Rather, the monitoring commences upon the user issuing a command to enter the feedback mode software in the feedback device, which is already up and running. The Examiner correctly points out that by recording the time at which the user enters the feedback mode, Boulton teaches automatically monitoring the user's usage. However, such monitoring occurs upon the user entering the feedback mode as opposed to upon start up of the feedback system. We therefore agree with Appellants that since Boulton only starts monitoring the user's interaction with the feedback system upon the user entering the feedback mode, the disclosed monitoring is user-initiated and it does not automatically begin upon starting up the feedback device.

9

Further, as noted above, Varga teaches a vending machine that commences monitoring of purchased goods thereon upon start up of the vending machine. (FF. 2.) We agree with Appellants that Varga cannot be properly combined with Boulton to yield the claimed commencing monitoring of the user's interaction with the image forming device upon starting up the device. Particularly, modifying Boulton to automatically commence monitoring of the user's feedback upon start up of the feedback device would be rather impractical since the process of providing feedback is ordinarily a voluntary exercise initiated by a user. The suggested combination would therefore defeat the purpose of the user opting to provide feedback, as intended by the Boulton system. It follows that Appellants have shown that the Examiner erred in concluding that the combination Boulton and Varga renders independent claim 1 unpatentable.

Since claims 5 through 9, 13 through 17, 21 through 25, and 29 through 36 recites the limitations of claim 1 discussed above, Appellants have shown error in the Examiner's rejection of these claims for the same reasons detailed above.

VI.   CONCLUSION OF LAW

Appellants have shown that the Examiner erred in concluding that claims 1, 5 through 9, 13 through 17, 21 through 25, and 29 through 36 are unpatentable as set forth above.

10

VII.   DECISION

We reverse the Examiner's decision to reject claims 1, 5 through 9, 13 through 17, 21 through 25, and 29 through 36.

<u>REVERSED</u>

MARTIN, *Administrative Patent Judge*, concurring.

I write separately because I would reverse the rejection for a different reason.

Before addressing that difference, I note by way of background that in Boulton the user can click on a "feedback icon" 62 in the learner interface 52 depicted in Figure 3a in order to access (i.e., display) the feedback interface 42 depicted in Figure 4. Boulton, col. 15, ll. 39-44.[3]

The feedback interface 42 preferably includes fields 57, attribute icons 76, a prompted feedback field 78, an input area 80, and a close box 81. *Id.*, col. 15, ll. 46-48. The attribute icons 76 include another "feedback icon" 82, an input mode icon 84, a situation attribute icon 86, a response attribute icon 88, a sharing attribute icon 90, and a send icon 92. *Id.*, col. 16, ll. 36-39. The feedback icon 82 allows the learner to select from different "feedback modes." *Id.*, col. 16, ll. 39-40.

Input area 80 is a message window 80 that is used by the learner to enter a specific feedback message about the selected subject/context. *Id.*, col. 17, ll. 8-10.

The Examiner treats the user's *selection* of a feedback mode as separate from *recording* the user's feedback comments, on which recording operation the Examiner reads the recited "monitoring" function. *See* Answer 7 ("[T]he step of activating an enter feedback mode command is

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[3] Alternatively, feedback interface 42 can be used as an independent application program, independent of a learning or other interface. *Id.*, col. 15, ll. 44-46.

totally different than the step of monitoring the user's feedback. . . . The step
of recording this feedback does not require a user's action to start a recording
program. When the user types his/her commands (being considered as
'plurality of operations by the user' as claimed in the claim language), the
system automatically starts to record the commands without any user's
action to initiate the recording system.").

Appellants responded to the Examiner's reading of "monitoring" on
Boulton's recording of feedback comments with several arguments. One is
that the feedback comments must be typed by the user before they are
recorded, with the result that the recording of those comments is not
automatically started "without the user directly starting a monitoring
program," as required by the independent claims. Br. 11.[4] The Examiner, in
response, more particularly reads the recited monitoring function on
recording the *time* at which feedback is made rather than on recording the
comments themselves. *See* Answer 7 ("Although Boulton does not clearly
recite the step of automatically monitoring the feedback without user's
action, Boulton discloses at column 4, lines 20-25, 'the method may also
include the step of recording in the feedback record the time at which the
feedback is made.'") (bolding omitted). The Examiner further explained
that "the time at which feedback is made" refers to the time when feedback
comments are entered and recorded. *See* Answer 7 ("[T]the feedback is
recorded at the time the feedback is made.").

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[4] All of the independent claims include the language argued by
Appellants.

Appellants argue that Boulton's recording of the time information is immaterial because "such a time, which may be automatically recorded in <u>Boulton</u>, does not at all result from 'monitoring data of selecting of the plurality of operations of the operation panel by the user,'" as claimed. Reply Br. 3. More particularly, Appellants argue that the claim language "operations on an operation panel selected by a user," when read on Boulton, "corresponds to the user typing in feedback comments." *Id*. To the extent Appellants are arguing that the recorded data (i.e., the recited "monitored data") must represent the information *in* the typed comments rather than the time when the comments were entered, I disagree. The claim language "data *of* selecting of the plurality of operations of the operation panel by the user" (emphasis added) is broad enough to read on data that identifies the time when the user began typing comments.

Appellants also argue that the Examiner erred in reading the "monitoring" function on the recording of data during the feedback mode because "in <u>Boulton</u> a must initiate an action to even perform the 'feedback' therein" (Br. 11). I agree. When, as proposed by the Examiner, the recited monitoring is read on recording the time when comments are being entered, the recording of the time necessarily begins in response to entry of those comments. Recording of the time in Boulton is therefore not done "without the user directly starting a monitoring program," as the Examiner appears to believe.

For the above reason, I agree with the Majority's decision that the rejection should be reversed with respect to all of the rejected claims.

msc

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